

Additionally, a minor typographical error in Claim 38 has been corrected. Support for the amendments is found in Applicants' Claims 37-39 as originally filed.

Attached hereto is a marked-up version of the changes made to the claims by current amendment. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**."

Upon entry of the amendments presented, Claims 11-39 remain in the application. No additional claims fee is believed due as a result of these amendments. Authorization, however, is given in the cover sheet to charge any fee due to the Assignee's deposit account.

REMARKS

Formal Matters

Rejection of Claims 11-39 under 35 USC §112, Second Paragraph

The Examiner has rejected Claims 38-39 under 35 USC §112, Second Paragraph stating that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the examples lack sufficient antecedent basis for use of the term "esterified polyol." Applicants respectfully traverse this rejection.

The Examiner states that there is insufficient antecedent basis for the term "esterified polyol" in Claims 38 and 39 because Claim 37, from which Claims 38-39 depend, is a "product-by-process" type. The Examiner states that because the rejected claims are directed towards a product they can not claim dependency from a product-by-process type claim. Applicants respectfully suggest that the Examiner is in error.

As recognized by the Examiner, Claim 37 is a product-by-process type claim wherein examination of the patentability of the claim focuses on the product, and not the process (Paper No. 7, Page 2, Third Paragraph, citing MPEP §2113). As Claim 38 is directed towards further defining the product of Claim 37, it is proper that Claim 38 depend from Claim 37. Moreover, as the term "esterified polyol" is properly first presented in Claim 38 with the appropriate article (e.g., an), Accordingly, Applicants respectfully assert that the Examiner's rejection of Claim 38 under 35 USC §112, Second Paragraph for lack of antecedent basis is in error. With respect to Claim 39, Applicants again respectfully bring to the Examiner's attention that this claim does not contain the term "esterified polyol."

Additional support for the term "esterified polyol" can be found at page 1, lines 22-23; page 2, line 5; page 18, line 12; and throughout the remainder of the Specification and Claims 1-10 as originally filed.

As Claims 38-39 are sufficiently definite and readily understood by those of ordinary skill in the art, and all terms have proper antecedent support, Applicants respectfully assert

that under 35 USC §112, Second Paragraph continued rejection for lack of antecedent basis is in error and should be withdrawn.

Rejection of Claims 11-39 under 35 USC §112, Second Paragraph

Claims 11-39 are rejected under 35 USC §112, Second Paragraph. In making the rejection, the Examiner states that Claims 11-39 are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because essential process steps have been omitted. Paper No. 7, Page 3, second paragraph). For the reasons set forth below, the rejection is hereby traversed.

In the present instance the Examiner has made a determination that the instant claims are indefinite because certain process steps are not specifically claimed. Applicants again assert that the legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope (*In re Warmerdam*, 31 USPQ 2d 1754, 1759 (Fed. Cir. 1994)), and that all that is required to comply with the requirements of 35 USC §112, second paragraph, is that the metes and bounds of what is claimed be determinable with a reasonable degree of precision and particularity (*Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989)).

Here, the claims meet those standards by expressly reciting the specific process steps that Applicants regard as their invention. The claims apprise what the invention is and 35 USC §112, second paragraph, does not require that the claims recite every combination or permutation of how it can be done.

To sustain a rejection under the second paragraph of 35 USC §112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). Here the Examiner has failed to establish that one of ordinary skill in the pertinent art would not have been able to ascertain with a reasonable degree of precision and particularity the metes and bounds set out and circumscribed by the claims. For this reason alone, the rejection cannot stand and should be withdrawn.

Applicants assert that it is not necessary to recite each and every step of a given process, nor is it necessary to define each and every element of a physical compound or structure for a claim to be patentable. As is clear from the present state of the law, all that is required to meet the test for indefiniteness is that ordinarily skilled artisan be able to ascertain with a reasonable degree of precision and particularity the boundaries of Applicants' claimed invention. Applicants respectfully assert that when read in light of the Specification those of ordinary skill in the art would fully and completely ascertain the metes and bounds of the present invention.

Applicants respectfully assert that the scope of Claims 11-39 is readily ascertainable to one skilled in the art when the claims are read in light of the description portion of the Specification and the state of the art as of the filing date of the present application. It is further submitted that the Examiner has not articulated any facts to support any conclusion to the contrary as is required to sustain the rejection under 35 USC 112, second paragraph. As such, Applicants assert that continued rejection of Claims 11-39 on these grounds is in error and should be withdrawn.

ART REJECTIONS

Rejection Under 35 USC §102(b)

The Examiner has rejected Claims 11-13, 17-18, 20, and 32 as being anticipated under 35 USC §102(b) by EP 0 391 485 A1 to Klok. For the reasons set forth below, the rejection is hereby traversed.

The Examiner has rejected Claims 11-13, 17-18, 20, and 32 over EP 0 391 485 A1, stating that the cited reference “teaches a process of preparing fatty acid lower alkyl esters wherein esters are formed via esterification, by-products separated via conventional water washing, the water-washed ester produced is distilled to produce an ester product of at least 98% purity, an acid value of less than 1.0, under elevated temperatures and pressure.” (Paper No. 5 at page 2). Applicants respectfully suggest that the Examiner’s conclusion is in error.

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Furthermore, in a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). “Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference “by page and line” upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

The present rejection fails to identify where in the cited reference (EP 0 391 485 A1) each and every element of the rejected claims are shown. Specifically, the rejection fails to identify where it is disclosed in the cited reference that the step of water washing the product mixture should be done **at an elevated temperature and an elevated pressure to remove at least a portion of the by-products from the product mixture**. The EP 0 391 485 A1

reference neither discloses nor suggests that the step of water washing should be performed at either elevated temperatures or elevated pressures. This is insufficient as a matter of law to support a conclusion of anticipation, and for this reason, the rejection is improper and should be withdrawn.

Conclusions

Applicants have made an earnest effort to place their application in proper form. WHEREFORE, entry of the amendments presented, reconsideration of this application, withdrawal of the rejections under 35 USC § 102(b), 35 USC § 112, Second Paragraph, and allowance of Claims 11-39 are respectfully requested.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES

Claim 38 has been amended as follows:

38. (Amended) An alkyl ester product made according to the process of claim 37, wherein the alkyl ester product comprises an esterified polyol selected from the group consisting of esterified alkoxylated glycerols, esterified linked alkoxylated glycerols, sucrose fatty acid polyesters and mixtures thereof.

Claim 39 has been amended as follows:

39. (Amended) An alkyl ester product made according to the process of claim 37, wherein the alkyl ester product comprises a polyol fatty acid polyester and less than about 0.5%, by weight, triglyceride.